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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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JOHN P. COSTELLO
331 J STREET, SUTIE 200
SACRAMENTO, CA 95814

EXAMINER	
VANATTA, AMY B	
ART UNIT	**PAPER NUMBER**
3765	

DATE MAILED: 08/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/718,873	NISKI ET AL.	
	Examiner	Art Unit	
	Amy B. Vanatta	3765	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 June 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *22-36* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *29,30,32,34 and 35* is/are allowed.

6)☒ Claim(s) *22,24-28,31,33 and 36* is/are rejected.

7)☒ Claim(s) *23* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *21 November 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 24, 25, 31, and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 24, 25 and 31 recite "said ends" without proper antecedent basis. This recitation is confusing since no ends were previously set forth.

Claim 33 recites "said neck opening" without proper antecedent basis. This recitation is confusing since no neck opening was previously set forth.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 22, 26, 27, and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Ellsworth et al (5,920,909).

Ellsworth et al disclose a protective wrap device which has the claimed structure. Regarding claim 22, the device of Ellsworth comprises a wrap 20 which forms a collar

as claimed comprising gatherable material (22) having an inner border (24) and an outer border (26). The inner border 24 forms an opening (see Fig. 3) which has a structure such that it could function as a neck opening for encircling the neck of a wearer. Furthermore, see Fig. 1A in which the wrap is shown around the neck and the inner border does form a neck opening. The outer border (26) communicates with a flexible hoop (30). The collar (22) is positioned inside of the flexible hoop (30) such that the collar spans inward of the hoop 30 towards the inner border to terminate at the opening 24 (see Fig. 3). The hoop 30 is made of a material (elastic) having a memory quality for allowing expansion and contraction of the hoop and collar as claimed. If positioned upon a neck (as in Fig. 1A), the hoop would be separated a distance from the wearer's neck by the collar (material 22) now lying in a gathered fashion about the neck (see Fig. 1A). With regard to claim 26, the collar (22) further comprises elastic material (28) coupled along the inner border as claimed. Ellsworth discloses that the gatherable material forming the device may be cotton cloth (see col. 1, line 40). Cotton cloth is an absorbent material as in claim 27.

Regarding claim 36, the device includes a hoop of memory material (elastic band 30) capable of expanding and contracting, a collar (22) which communicates with the hoop, the collar comprising an area spanning inward of the hoop 30 (see Fig. 3) and terminating at the interior opening (24) as claimed. The hoop (30) places an encircling tension upon the collar (20) as claimed (see Figs. 1A, 2, and 3).

It is noted that the inner border of the device does include tensioning means (elastic 28) and the extent to which the inner border of the collar is "tensioned snugly"

about the wearer's neck is dependent upon the size of the wearer's neck. Furthermore, it is noted that the recitations regarding the inner opening being a "neck opening" for encircling the wearer's neck amounts to the intended use of the device (i.e. use around the neck portion of the wearer's body). It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham,* 2 USPQ2d 1647 (1987). The device of Ellsworth is clearly capable of being positioned around the neck (also note Fig. 1A, in which the device is shown around the neck).

The recitation of the device as a "bib" in the preamble does not further define the claimed invention over that of Ellsworth, since the device of Ellsworth has the "bib" structure to the extent claimed and clearly is capable of being used or worn around the neck. Furthermore, the preamble is generally not accorded any patentable weight where it merely recites the intended use of a structure (i.e. use as a "bib"), and where the body of the claim does not depend on the preamble for completeness but, instead, the structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). The term "bib" as recited in the preamble does not impart any structure to the claimed invention which defines over that of Ellsworth. Furthermore, the recitation of the use of the device as a bib does not define over the structure of Ellsworth, since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed

apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham,* 2 USPQ2d 1647 (1987).

5. Claims 22, 25, 26, 28 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Varell (2,211,184).

Varell discloses a protective headband device which has the claimed structure. Regarding claim 22, the device of Varell comprises a material 6 which forms a collar as claimed comprising gatherable material (pg. 1, col. 2, lines 38-41) having an inner border (7) and an outer border (8). The inner border 7 forms an opening (see Fig. 2) which has a structure such that it could function as a neck opening for encircling the neck of a wearer. The outer border 8 communicates with a flexible hoop (12). The collar (6) is positioned inside of the flexible hoop 12 such that the collar spans inward of the hoop 12 towards the inner border 7 to terminate at the inner opening (see Fig. 2). The hoop 12 is made of a material (elastic) having a memory quality for allowing expansion and contraction of the hoop and collar as claimed. If positioned upon a neck, the hoop would be separated a distance from the wearer's neck by the collar (material 6) now lying in a gathered fashion about the neck (see Fig. 2 and see pg. 1, col. 2, lines 38-41 and pg. 2, col. 1, lines 65-69). With regard to claim 25, the ends of the material 6 overlap when the hoop is in a contracted state (see embodiment of Fig. 4), the overlapped ends of material 6 being attached by hooks and loops 15,16 (Fig. 4). Regarding claim 26, the collar 6 further comprises elastic material 11 coupled along the

inner border as claimed. The gatherable material forming the device is water-proof (pg. 1, col. 2, line 16), thus being non-absorbent as in claim 28.

Regarding claim 36, the device includes a hoop of memory material (elastic band 12) capable of expanding and contracting, a collar 6 which communicates with the hoop, the collar comprising an area spanning inward of the hoop 12 (see Fig. 2) and terminating at the interior opening (at edge 7) as claimed. The hoop 12 places an encircling tension upon the collar 6 as claimed (pg. 1, col. 2, lines 38-41).

It is noted that the inner border of the device does include tensioning means (elastic 11) and the extent to which the inner border of the collar is "tensioned snugly" about the wearer's neck is dependent upon the size of the wearer's neck. Furthermore, it is noted that the recitations regarding the inner opening being a "neck opening" for encircling the wearer's neck amounts to the intended use of the device (i.e. use around the neck portion of the wearer's body). It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham,* 2 USPQ2d 1647 (1987). The device of Varell is clearly capable of being positioned around the neck and functioning as claimed.

The recitation of the device as a "bib" in the preamble does not further define the claimed invention over that of Varell, since the device of Varell has the "bib" structure to the extent claimed and clearly is capable of being used or worn around the neck. Furthermore, the preamble is generally not accorded any patentable weight where it merely recites the intended use of a structure (i.e. use as a "bib"), and where the body

of the claim does not depend on the preamble for completeness but, instead, the structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). The term "bib" as recited in the preamble does not impart any structure to the claimed invention which defines over that of Varell. Furthermore, the recitation of the use of the device as a bib does not define over the structure of Varell, since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham,* 2 USPQ2d 1647 (1987).

6. Claims 22, 25, 26 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Wolff (815,998).

Wolff discloses a protective device which has the claimed structure. Regarding claim 22, the device of Wolff comprises a material 1 which forms a collar as claimed comprising gatherable material having an inner border (at band 2) and an outer border (at 3); see Fig. 2. The inner border forms an opening (see Fig. 2) which has a structure such that it could function as a neck opening for encircling the neck of an infant wearer. Such a function is dependent upon the size of the wearer relative the size of the device. The size of a large grown man's arm, for which the device of Wolff may be manufactured, approximates the size of a small infant's neck. Thus, the opening of the device of Wolff, made to fit a grown man's arm, would appear to fit snugly around an

infant's neck. The outer border communicates with a flexible hoop (3). The collar 1 is positioned inside of the flexible hoop 3 such that the collar spans inward of the hoop 3 towards the inner border (at 2) to terminate at the inner opening (see Fig. 2). The hoop 3 is made of a material (flat metallic or bone spring; lines 43-53) having a memory quality for allowing expansion and contraction of the hoop and collar as claimed. If positioned upon a neck, the hoop 3 would be separated a distance from the wearer's neck by the collar (material 1) now lying in a gathered fashion about the neck (see Fig. 2). With regard to claim 25, the ends of hoop 3 overlap when the hoop is in a contracted state (see Fig. 2 and lines 44-47). Regarding claim 26, the collar 1 further comprises elastic material (2) coupled along the inner border as claimed (see lines 39-40).

Regarding claim 36, the device includes a hoop of memory material (3) capable of expanding and contracting, a collar 1 which communicates with the hoop, the collar comprising an area spanning inward of the hoop 3 (see Fig. 2) and terminating at the interior opening (at 2) as claimed. The hoop 3 places an encircling tension upon the collar 1 as claimed.

It is noted that the inner border of the device does include tensioning means (elastic 2) and the extent to which the inner border of the collar is "tensioned snugly" about the wearer's neck is dependent upon the size of the wearer's neck. Furthermore, it is noted that the recitations regarding the inner opening being a "neck opening" for encircling the wearer's neck amounts to the intended use of the device (i.e. use around the neck portion of the wearer's body). It has been held that a recitation with respect to

the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham,* 2 USPQ2d 1647 (1987). The device of Wolff is clearly capable of being positioned around the neck of a small infant and functioning as claimed.

The recitation of the device as a "bib" in the preamble does not further define the claimed invention over that of Wolff, since the device of Wolff has the "bib" structure to the extent claimed and clearly is capable of being used or worn around the neck. Furthermore, the preamble is generally not accorded any patentable weight where it merely recites the intended use of a structure (i.e. use as a "bib"), and where the body of the claim does not depend on the preamble for completeness but, instead, the structural limitations are able to stand alone. See *In re Hirao,* 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). The term "bib" as recited in the preamble does not impart any structure to the claimed invention which defines over that of Wolff. Furthermore, the recitation of the use of the device as a bib does not define over the structure of Wolff, since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham,* 2 USPQ2d 1647 (1987).

Allowable Subject Matter

7. Claims 29, 30, 32, 34, and 35 are allowed.

8. Claim 23 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Claim 24 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

10. Claims 31 and 33 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Response to Arguments

11. Applicant's arguments with respect to claims 22-36 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy B. Vanatta whose telephone number is 703-308-2939. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert can be reached on 703-305-1025. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Amy B. Vanatta
Primary Examiner
Art Unit 3765